

REMARKS

In response to the Office Action mailed July 26, 2005, the present application has been carefully reviewed and amended. Entry of the present amendment and reconsideration of the application are respectfully requested.

Claim Rejections under 35 USC §102

Claims 63, 69 -70, 72, 74 - 75, 80 - 82, 84, 86 - 87, 92 - 94 and 96

Claims 63, 69 - 70, 72, 74 - 75, 80 - 82, 84, 86 - 87, 92 - 94 and 96 stand rejected under 35 USC §102(b) as being anticipated by Fabris et. al. (US 4,676,995). [Paper 07192005, page 2]

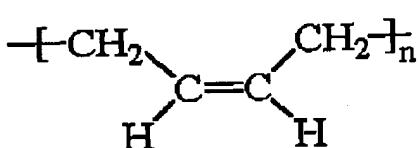
The Examiner asserts Fabris "discloses ... the layers also comprise a polybutadiene (column 3, lines 64 - 65)." [Paper 07192005, page 3]

Applicant respectfully submits Fabris does not disclose a polybutadiene. Specifically, column 3, lines 64 -- 65 are reproduced below:

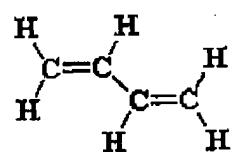
high trans random SBR's; butadiene- or isoprene-styrene star copolymers; block (thermoplastic elastomer) 65 (Col. 3)

That is, Fabris discloses a butadiene. Butadiene is a gaseous hydrocarbon.

Claims 63 recites in part "a polybutadiene". Polybutadiene is a solid synthetic rubber, not a gas.



polybutadiene



butadiene

The absence of at least this limitation precludes Fabris from sustaining the asserted rejection.

Fabris is also relied upon to disclose "that both layers are uncured curable layers comprising sulfur and peroxide curing agents, which are there for sulfur and peroxide curable; the layers also comprise a polybutadiene (column 3, lines 64 -- 65). [Paper 07192005, page 3]

Applicant respectfully submits the disclosed laundry list of agents (curing and compounding) set forth in Fabris and cited by the Examiner at column 4, lines 1 - 8 is not a list of agents included in each layer, but rather a list from which certain agents can be chosen.

The inclusion of each agent in the list in each layer is not possible in view of the disclosure of Fabris and does not make sense. For example, the list includes "blowing agents". However, as shown in Figures 1, 3, 5 and 6 Fabris employs a solid (dense, not foamed) rubber 3.

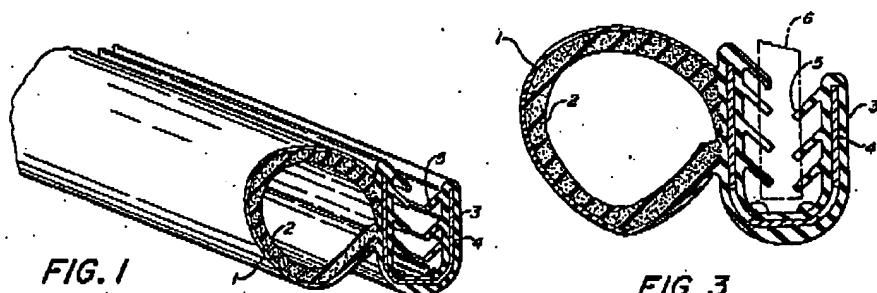


FIG. 1

FIG. 3

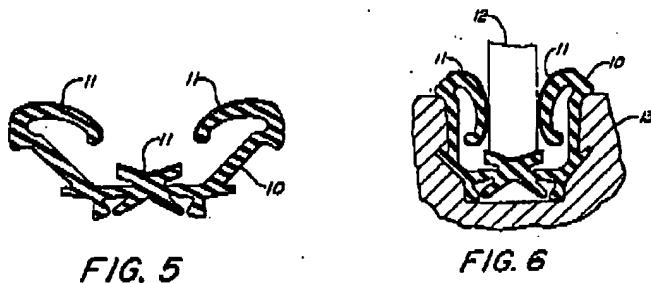


FIG. 5

FIG. 6

It would be impossible to produce the preferred embodiment with the dense rubber 3 as shown in these Figures if each of the agents (including the blowing agents) from this laundry list were included in both rubber layers.

Further, the list recites "retarders" and "accelerators". It appears nonsensical to add both a retarder and an accelerator. Similarly, the list includes reinforcing blacks (which are used to impart a solid black color to the product) as well as TiO<sub>2</sub> (titanium dioxide) which is used to color components white. To include both these agents would be to color the rubber black and color the rubber white.

Alternatively, if Fabris is relied upon to disclose merely that a subset of these agents can be in the layers, Fabris still fails to disclose the recited limitations. There is no disclosure of the peroxide curable rubber layer on the metal reinforcement with a sulfur curable rubber layer on at least a portion of the peroxide curable rubber layer.

About the most that can be said for the Lemelson patent is that it does not explicitly describe anything inconsistent with angioplasty procedures. However, this negative pregnant is not enough to show anticipation. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) (in order to anticipate, "the [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it"). *Rowe v. Dror*, 42 USPQ2d 1550, 1550 (Fed. Cir. 1997)

Further, with respect to the recitation of a genus,

A prior art reference that discloses a genus still does not inherently disclose all species within that broad category. See *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1262, 9 USPQ2d 1962 (Fed. Cir. 1989) ("Under [defendant's] theory, a claim to a genus would inherently disclose all species. We find [this] argument wholly meritless...."). *Metabolite Laboratories Inc. v. Laboratory Corp. of America Holdings*, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004)

Therefore, Fabris cannot sustain a rejection of the present claims which recite in part "an uncured peroxide curable rubber layer on the metal reinforcement, the uncured peroxide curable rubber layer including one of a polybutadiene and a (meth)acrylate; and (b) an uncured sulfur curable rubber layer on at least a portion of the uncured peroxide curable rubber layer, the uncured sulfur curable rubber layer comprising a sulfur curing agent" (Claims 63-73); "an uncured peroxide curable bonding veneer on at least a portion of the metal reinforcement, the uncured peroxide curable bonding veneer comprising a peroxide curing agent; and (c) an uncured sulfur curable rubber layer on at least a portion of the uncured peroxide curable bonding veneer, the uncured sulfur curable rubber layer comprising a sulfur curing agent" (Claims 74-85) and "an uncured peroxide curable bonding veneer on at least a portion of the metal reinforcement, the uncured peroxide curable bonding veneer comprising a peroxide curing agent; and (c) an uncured non-peroxide cross linkable elastomer layer on at least a portion of the uncured peroxide curable bonding veneer, the uncured non-peroxide cross linkable elastomer layer comprising a sulfur curing agent." (Claims 86-97).

Further, Applicant notes the laundry list of Col. 4 relied upon by the Examiner recites at least 23 agents. Thus, there are 23! different combinations of the agents. This provides  $2.5852 \times 10^{22}$  (25,852,000,000,000,000,000,000) different combinations of the listed agents. Applicant respectfully submits this is insufficient to place the present combination in the possession of one of ordinary skill in the art.

As Fabris does not disclose each limitation of the rejected claims, nor provide an enabling disclosure of the claimed subject matter, the rejection under 35 USC §102 cannot be sustained.

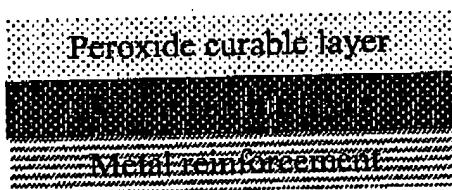
Rejections under 35 USC §103

**Claims 64-68, 71,73,76-79,83,85, 88-91,95 and 97**

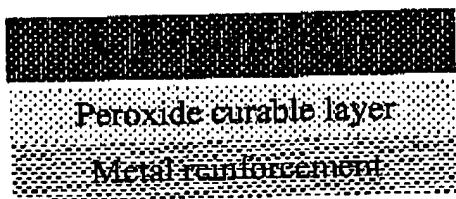
Claims 64-68, 71,73,76-79,83,85, 88-91,95 and 97 stand rejected under 35 USC §103 as being unpatentable over Fabris (US 4,676,995) in view of Drake (US 5,521,248).

The Examiner asserts "one of ordinary skill in the art would have recognized the advantage of providing for the peroxide curable layer comprising maleinated polybutadiene and methacrylate and encapsulating a sulfur curable layer and a metal reinforcement" [Paper 07192005, page 4]

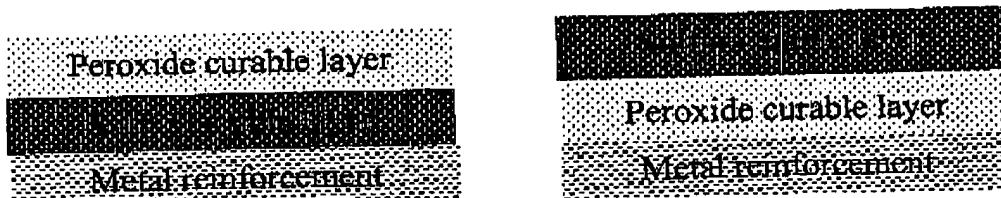
That is, the Examiner asserts the cited references render the following order obvious:



In contrast, all the present claims recite the order:



The present claims recite an order that is opposite the order the Examiner asserts is obvious.



## [Cited references]

## [Present claims]

Applicant notes Claims 86-97 recite an "uncured non-peroxide cross linkable elastomer layer on at least a portion of the uncured peroxide curable bonding veneer, the uncured non-peroxide cross linkable elastomer layer comprising a sulfur curing agent" in place of the "sulfur curable layer". However, the this recitation does not alter the relative ordering of the layers, which ordering is opposite to that taught by the cited references.

Therefore, applicant respectfully submits the asserted rejections under 35 USC §103 cannot be sustained as the asserted obvious order is opposite to the presently claimed order.

Fabris is further relied upon to disclose the layer "that contacts the metal reinforcement also encapsulates the metal reinforcement (containing the metal reinforcement; column 2, lines 4-6)." [Paper 07192005, page 3]

However, Claims 71, 83 and 95 require the uncured sulfur (non peroxide – Claim 95) curable layer substantially encapsulate[s] the uncured peroxide curable layer (rather than the layer encapsulates the metal reinforcement). Neither of the cited references discloses the recited encapsulation of one layer by the other layer.

None of the layers of Fabris encapsulate another layer. The examiner relied upon element 2 as one layer and element 3 as a second layer. However, layer 2 does not substantially encapsulate layer 3 and layer 3 does not substantially encapsulate layer 2.

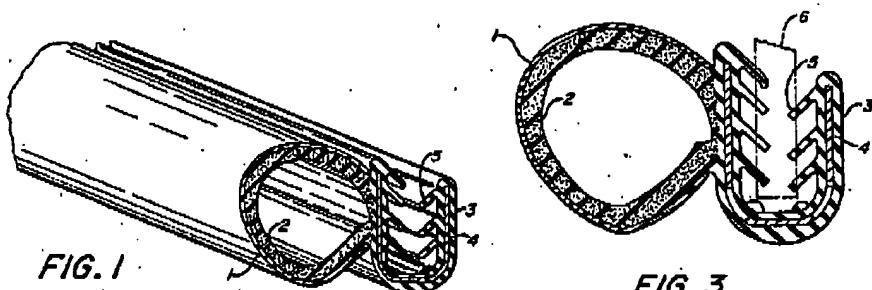


FIG. 1

FIG. 3

Drake does not cure the deficiencies of Fabris. Drake has been relied upon to assert the flowable material encapsulates, citing column 6, lines 45-47. Specifically,

45 The flowable mixture is then applied to a substrate, such as a plastic or metal automobile part, a further substrate whose bonding to the first substrate is desired is then placed in contact with the flowable mixture, and the mixture is cured in situ, resulting in a strong bond between the substrates. Preferably the bond is at least as strong under stress conditions such as tearing and pulling, as the substrates themselves.

(Col. 6)

Applicant respectfully submits this does not disclose that the flowable mixture encapsulates. In fact, Drake suggests there is no encapsulation. That is, Drake characterizes the bond strength as at least as strong as the substrates themselves. As expressly stated, Drake is directed to bonding substrates together (Col. 1, lines 15-17). If the materials were encapsulated as suggested by the examiner, the substrates would not determine the bond strength. Rather, only the encapsulating material would define bond strength, as only bonding material would form an integral material against which the bond strength is measured.

Therefore, applicant respectfully submits all the pending claims, Claims 63-97, are in condition for allowance and such action is earnestly solicited. If any further issues remain, the Examiner is cordially invited to call the undersigned so that any such matters may be promptly resolved.

Respectfully submitted,

  
\_\_\_\_\_  
Brian B. Shaw, Registration No. 33,782  
HARTER, SECREST & EMERY LLP  
1600 Bausch & Lomb Place  
Rochester, New York 14604  
Telephone: 585-232-6500  
Fax: 585-232-2152

Dated: October 11, 2005

17/17